

REMARKS

Claims 1-43 are pending in this application, of which claims 1 and 2 are independent. Claims 1, 3, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37, 39 and 41 stand withdrawn from consideration pursuant to the previous restriction requirement.

Claims 4, 5, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, 36, 38, 40, 42 and 43 were objected to and would be allowed if recast in independent form. The Examiner indicated that claim 43 would be allowed if recast in independent form and included subject matter of the elected claims and not the withdrawn claims.

Applicants respectfully request consideration of the Information Disclosure Statement filed concurrently herewith.

Claim 2 was rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Itoh (U.S. Patent No. 6,042,234, hereinafter "Itoh"). In the statement of the rejection, the Examiner referred to FIGS. 1-3 of Itoh, asserting the disclosure of a color separating and mixing element corresponding to that defined in claim 2. Applicants respectfully traverse.

Applicants would stress that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed invention and the device of Itoh that would preclude the factual determination that Itoh identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claim 2 recites the following:

A color separating and mixing element comprising, in its transparent cube, a first optical function surface and a second optical function surface which are unparallel to each other, first and second faces of the cube being respectively taken as light incidence surfaces, third, fourth and fifth faces of the cube being respectively taken as light incidence/output surfaces, and a sixth face of the cube being taken as a light output surface,

one light in the primary color which is predetermined polarized light incident on the first face of said cube passing through the first optical function surface and being emitted from the third face of the cube, said one light in the primary color returned after the direction of polarization thereof is rotated by 90° being received in the third face of the cube, and the one light in the primary color being reflected by the first optical function surface and being emitted from said light output surface,

one, which is predetermined polarized light, of two lights in the primary colors incident on the second face of said cube passing through the second optical function surface and being emitted from the fourth face of the cube, said one light in the primary color returned after the direction of polarization thereof is rotated by 90° being received in the fourth face of the cube, the one light in the primary color being reflected by the second optical function surface and being emitted from said light output surface, and

the other one, which is predetermined polarized light, of the two lights in the primary colors incident on the second face of said cube being reflected by the second optical function surface and being emitted from the fifth face of the cube, said other one light in the primary color returned after the direction of polarization thereof is rotated by 90° being received in the fifth face of the cube, and the other one light in the primary color passing through the second optical function surface and being emitted from said light output surface.

The polarized light separating and synthesizing optical element of Itoh separates and synthesizes only by polarization dependency. In other words, the polarized light separating and synthesizing optical element of Itoh does not have selectivity related to color (wavelength selectivity). On the contrary, the color separating and mixing element recited of claim 2 has both polarization dependency and wavelength selectivity. Thus, the configuration and function of the present claimed subject matter is patentably distinct from the teachings of Itoh.

The above argued differences between the claimed subject matter and the device of Itoh undermines the factual determination that Itoh identically discloses a device corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*,

976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 2 under 35 U.S.C. § 102 for lack of novelty as evidenced by Itoh is not factually viable and, hence, solicit withdrawal thereof.

Applicants note the Examiner's Statement of Reasons for Allowance included on page 5 of the Office action. Entry of that Statement into the record should not be construed as any agreement with or acquiescence by Applicants in the reasoning stated by the Examiner. Applicants positions on the issues appear in Applicants' response. The Statement of Reasons for Allowance should not be used to interpret the cited claims, particularly to the extent if any that the Statement of Reasons for Allowance may differ from the express language of the claims and/or Applicants' positions on patentability of those claims. It is respectfully submitted that the allowed claims should be entitled the broadest reasonable interpretation and broadest range of equivalents that are appropriate in light of the language of the claims, the supporting disclosure and Applicants' prosecution of the claims, without reference to the Statement of Reasons for Allowance.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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